



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,701	01/07/2000	MAKOTO KOBAYASHI	12989-JA998	4634

7590 02/05/2004

RICHARD L CATANIA ESQ
SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY, NY 11530

EXAMINER

JAROENCHONWANIT, BUNJOB

ART UNIT	PAPER NUMBER
----------	--------------

2143

DATE MAILED: 02/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s) N .

Applicant(s)

09/480,701

KOBAYASHI ET AL.

Examiner

Art Unit

Bunjoo Jaroenchonwanit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/15/03 has been entered and fully considered, as followed below.

2. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-4, 6, 7, 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Pacifici et al (US. 6,230,171).

5. As to claims 1, 3, 4, 9-11 Pacifici discloses a method and apparatus (hereafter a system) for sharing HTML Documents, i.e., shared web page, including a markup system includes a

Art Unit: 2143

Markup manager, i.e., NodeManager, for controlling browser in each of collaboration nodes (410, Fig.1). A markup Agent (412), i.e., PageManager, for controlling, detecting changes of a shared web page, sending the change to the controller(s) and/or receiving the changes from the controller, in the respective frame (412, Fig 4). The system further includes a browser in each of the client nodes, which is capable of presenting multiple frames (Fig. 4). Furthermore, Pacifici discloses the Markup Agent comprises a module for capturing event (416) for detecting changes, e.g., user interaction or URL changes, in the shared web page, communicating the changed between the surrogate and the controller, i.e., sending/receiving changes between PageManager and NodeManager (abstract; Fig. 2; Col. 4, line 10-Col. 5, line 47; Col. 6, lines 15-57). Furthermore, Pacifici includes a means for inserting Java script for functioning as Markup Agent, which invoking within each and every shared document, i.e., server include a means for embedding PageManager in each page (Col. 4, lines 27-32).

6. Regarding claim 8, Pacifici discloses the Markup system is Java Script (Col. 4, lines 9-26), i.e., a PageManager is embedded as Java applets which have an identical domain and data communication by shared memory is performed between said PageManager and said NodeManager.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being anticipated by Anupam et al (US. 6,411,989) and Pacifici et al., (U.S. 6,230,171).

9. Regarding claims 1, 3, 4, 9-11, Anupam discloses a method and apparatus (hereafter a system) for sharing Web-top, i.e., shared web-page, browser, having a manager and a controller

Art Unit: 2143

for controlling browser in each of collaboration nodes, i.e., NodeManager, and each of the nodes includes a surrogate, i.e., PageManager, for controlling, detecting changes of a shared web page, sending the change to the controller(s) and/or receiving the changes from the controller.

Furthermore, Anupam discloses the surrogate is capable of detecting changes, e.g., user interaction or URL changes, in the shared web page, communicating the changed between the surrogate and the controller, i.e., sending/receiving changes between PageManager and NodeManager (abstract fig. 2; Col. 3, line 40-Col. 4, line 18). Such teaching infers that the means for detecting change and means for receiving changes are inherent.

Even though, Anupam failed to disclose an embedding means, or embedder, in a server, for embedding PageManager in each of the page, but such means is no novelty. In analogous art, Pacific employed the same concept in its web based collaboration system for allowing each client terminal to shared HTML document, e.g., page. Furthermore, to detecting change within the page at each client, Pacific insert "Markup Agent" in each page and download to each of the client browser, The "Markup Agent" function and structure is clearly equivalent to the claimed PageManager (abstract; Fig. 2-4; Col. 4, line 10-Col. 5, line 47; Col. 6, lines 15-57).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to Modify Anupam's collaboration system with the Pacific's concept, with to embedded the Surrogate applet within each web page as suggested by Pacific's Markup Agent' concept, with the motivation to provide a platform independent that capable of directly annotating page, dynamically added the annotation as the page component for operable across the platform as well as specific browser (Col. 2, lines 60-67). .

Art Unit: 2143

10. Regarding claim 2, Anupam-Pacifici discloses a server includes manager for control session between collaborative browsers, controlling list of document to be reviewed by the perspective collaborator, and displaying pages previously created to the new participant, visiting the sequence URL to review its history, (Anupam, Col. 3, lines 24-40; Col. 4, lines 33-67) e.g., computer U-N. Such teaching infers that the page and changed pages are stored, e.g., cache in the server for later presentation. Further, Anupam-Pacifici discloses the system using JAVA applet to create a surrogate and Markup Agent, in each browser and page, i.e., the server embedding PageManager for controlling pages in each page (Pacifici, Col.4, and lines 9-26).
11. Regarding claim 5, Anupam-Pacifici discloses the surrogate periodically check the document structure changes (Anupam, Col. 5, lines 19-34; Col. 6, lines 8-40).
12. Regarding claim 6, Anupam-Pacifici discloses the manager-controller located in the server (Anupam, Fig. 2), i.e., independently from browsers, does not migrate, control communication including dynamically generate and terminate session.
13. Regarding claim 7, Anupam-Pacifici discloses the manager created lists of on going session, which previously created by computer U-1, to be displayed or reviewed in a new participant computer U-N, i.e., transition history of a page (Anupam, Col. 3, lines 24-40; Col. 4, lines 33-53).
14. Regarding claim 8, Anupam-Pacifici discloses, a PageManager is embedded as Java applets which have an identical domain and data communication by shared memory is performed between said PageManager and said NodeManager, e.g., a Surrogate and Markup agent are JAVA applets created for communicating with the controller in the same domain (Pacifici, Col. 4, lines 9-32).

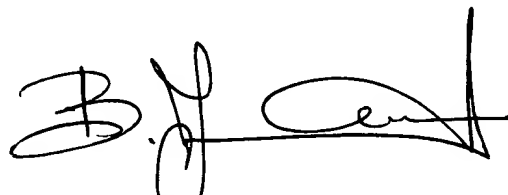
Art Unit: 2143

15. Applicant's arguments with respect to claims 1, 9, 10 and 11 have been considered but are moot in view of the new ground(s) of rejection.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bunjob Jaroenchonwanit whose telephone number is (703) 305-9673. The examiner can normally be reached on 8:00-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (703) 308-5221. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800.

A handwritten signature in black ink, appearing to read 'Bunjob Jaroenchonwanit', with a stylized, flowing script.

Bunjob Jaroenchonwanit
Primary Examiner
Art Unit 2143

/bj
February 2, 2004